

REMARKS

Claims 37, 38 and 42-46 stand rejected. Claims 37, 38 and 43 have been amended, claim 46 has been cancelled, and new claims 56-68 have been added in order to present the full scope of allowable subject matter. No new matter has been added by way of these amendments.

The Advisory Action

Claims 37, 38 and 42-46 stand rejected for allegedly failing to comply with the enablement requirement. While all of the prior art rejections had been met, according to the Examiner, the application was not in condition for allowance because it "does not overcome the enablement rejection for using the instant compounds in combination with active substances and/or principal adjuvants". Applicant respectfully traverses.

Claims 37 and 38 have been amended to remove those recitations to which the Examiner has rejected. Support for the amendatory language for the methods of using each of the compounds, as claimed, alone with a carrier can at least be found, for example, at paragraph [0027]. Therefore, claims 37 and 38 and, certainly, claims 42-45, which contain the amendatory language should also be found allowable. In view of the amendment to claims 37 and 38, claim 46 has been cancelled, and the rejection as to that claim is now moot.

Claims 56-63

Applicant has added new claims 56-63, which recite methods of using the claimed compositions for lightening the skin and slimming. In the past, and in connection with the above claims, the Examiner has rejected the methods of using of these claimed compositions as not being enabled, to which Applicant strongly disagreed. To the extent that the Examiner might have similar thoughts as to these claims, Applicant respectfully points out that some of the molecules of formula I are known in the art and others are made in accordance with the

invention. While the cited references do not negate the novelty of the claimed invention, the references provide evidence of the level of skill in the art and proof that these claims are, in fact, enabled. It would be counterintuitive, at least, to suggest that a skilled scientist of the dermatopharmaceutical arts could not synthesize or ascertain the claimed compounds, test them for efficacy, and combine them in formulations in the manner taught by Dr. Lintner in the specification, particularly in view of the ample evidence discussed above. Indeed, a patent need not teach, and preferably omits, that which is well-known in the art. For specificity, the claims now indicate the principal adjuvants and active substances that can be combined with the claimed compounds for their intended purposes.

Claims 64-68

Claims 64-68 recite a topical cosmetic product including the concentration of the specific compound contained therein and the specific actives and principal adjuvants which can be combined in the topical product and administered topically to the skin of a person in need thereof. The Examiner will note that similar claims were cancelled in an effort to advance prosecution of the method claims in view of a telephone interview, which did not result in an allowance. The claims, which were and are patentable, have been reintroduced for further consideration.

Despite the teachings in the Examiner-cited art that discloses oral dosage formulations (*i.e.*, dosage forms configured for enteral or parenteral administration) of some noraporphine compounds, nothing in the art of record anticipates claims drawn to topical cosmetic products or dermatopharmaceutical compositions as recited in claims 64-68, which are configured for topical administration to the skin of a person in need thereof.

Should the Examiner have any questions with regard to the foregoing, the Examiner should contact Applicant's attorney at the Examiner's convenience at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

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